

REMARKS/ARGUMENTS

I. Status of the Claims:

Prior to entry of this amendment, claims 17-39 were pending in the application, with claims 26-37 withdrawn as directed to non-elected inventions. Upon entry of this amendment, claims 17-20, 22 and 25 are amended without prejudice or disclaimer. These claims are amended solely for increased clarity. The rewording, however, does not narrow the scope of the claims. The amended claims are thus entitled to the original scope of equivalents.

II. Abstract

An abstract on a separate sheet is provided as requested by the Examiner.

III. Information Disclosure Statement

The Examiner continues to contend that the Information Disclosure statement filed "May 8, 2000" (it is believed this should be "May 18, 2000") fails to comply with the provisions of the MPEP because it includes documents that have not been translated. Specifically, on page 3 of the Office Action it is stated that documents AI, AK, AL, AM, AN and AO filed on May 8, 2000 have not been considered. Later, on page 6, it is stated that a translation of reference AE (WO 97/39033) has not been provided.

In response, Applicants reiterate the point made in the last response, namely that English language equivalents for each of the non-English references objected to by the Examiner were provided with the IDS filed August 9, 2001. The following chart (part of the one provided with the last response) summarizes these equivalents.

Specifically, the English language equivalents are as follows:

<u>Ref. No.</u>	<u>Document No.</u>	<u>English Language Equivalent</u>
May 18, 2000 AI	EP 0 416 983	5,679,776
May 18, 2000 AK	EP 0 714 987	5,858,658
May 18, 2000 AL	EP 0 714 988	5,789,153

May 18, 2000 AM

DE 35 04- 385

4,578,218

Applicants also reemphasize that the Examiner has provided applicants with a marked up copy of the IDS showing that *each* of these English language equivalents has already been considered. By considering these English language equivalents, the Examiner has thus considered the corresponding non-English language documents. Nonetheless, to ensure that the Examiner has the necessary documents, applicants are resupplying courtesy copies of each of the foregoing references.

The Office Action also states that translations of the documents AB, AC and AD listed on the Nov. 8, 2002 IDS were not found in the application (AB and AC of the November 8, 2002 IDS are translations of the documents listed as AN and AO on the May 18, 2000 IDS). A postcard showing receipt of these materials by the U.S. Patent Office on February 20, 2003 is enclosed. Applicants, however, are also enclosing courtesy copies of these documents.

IV. Claim Rejections under 35 U.S.C. 112, Second Paragraph

Claim 18 is said to be indefinite because it is unclear what components are bound together and what is eluted. Claims 17 and 18 have been reworded to provide greater clarity.

Claim 21 is rejected because the phrase "substantially free" is said to be indefinite. In response it is noted that this phrase as used with respect to the concentration of nucleic acids present (i.e., the context in which the phrase is used in the claim) is explicitly defined at page 13, lines 1-5. Thus, it is submitted that the meaning of the claim is clear.

V. Double Patenting

A terminal disclaimer is enclosed to address the double patenting rejection.

Application No. 09/367,459  
Amendment dated July 16, 2003  
Reply to Office Action of February 21, 2003

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Scott Ausenhus", written in a cursive style.

Scott L. Ausenhus  
Reg. No. 42,271

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000  
Fax: 415-576-0300  
SLA:tnd  
DE 7103029 v1